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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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24628 7590 03/31/2009 Husch Blackwell Sanders, LLP Husch Blackwell Sanders LLP Welsh & Katz 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				
EXAMINER				
RIVIERE, HEIDI M				
ART UNIT		PAPER NUMBER		
3689				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/757,206

**Applicant(s)**

HALLIGAN ET AL.

**Examiner**

HEIDI RIVIERE

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 124-134 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 124-134 is/are rejected.
- 7) ☒ Claim(s) 124, 128 and 132 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on **23 January 2009** has been entered.

### ***Response to Remarks***

2. Applicant's arguments filed **23 January 2009** have been fully considered but they are not persuasive. Applicant has cancelled the previous claims and presented all new ones. The remarks as presented address the Board of Patent Appeal and Interferences earlier decisions. The newly presented claims are currently rejected below.

### ***Claim Objections***

3. **Claims 124, 128 and 132** are objected to because of the following informalities: Claims 124 and 128 present a confusing use of semi-colons in the first limitation and likewise for claim 132 in the second limitation. As written the claims are not clear whether there are 6 or 11 limitations for example. If the later is the case then proper

method claim format is required with active verb agreements. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 124-134** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The six factors of the Restatement on Torts are not noted in the specification. The specification contains no mention of a documentation tool.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 124-127** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unsure whether documentation tool refers to Microsoft word or a kind of computer for example. As a result, this term will be interpreted as )

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 124-134** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Barney et al. (US 6,556,992 B1)** (hereinafter "**Barney**").

10. **With respect to claims 1-123 (canceled).**

11. **With respect to claims 124 and 128:** (new) A method for scoring, with a trade secret documentation tool, a potential trade secret, the method comprising:

presenting the six factors of a trade secret from Section 757 of the Restatement (First) of Torts to an evaluator via a trade secret documentation tool using a user interface device connected to an accounting digital computer, the six factors including (1) the extent to which the information is known outside of his business; (2) the extent to which it is known by employees and others involved in his business; (3) the extent of measures taken by him to guard the secrecy of the information; (4) the value of the information to him and to his competitors; (5) the amount of effort or money expended by him in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others; (Barney: col. 12 – computer model or computer algorithm used)

- presenting to an evaluator, via the trade secret documentation tool using a user interface device connected to the accounting digital computer, a plurality of different ratings for each of the six factors, with each rating having an associated numerical value; (Barney: col. 7, line 15-col. 8, line 67; col. 30, lines 25-45; cols. 25 and 26 – system to be used with intellectual property assets; numeric and alphanumeric scores assigned in rating assets)
- receiving, via the trade secret documentation tool using a user interface device connected to the accounting digital computer, a respective rating of the presented ratings from the evaluator as to the extent that the potential trade secret meets each of the six factors; (Barney: col. 28 – Internet used to present rating information to subscribers)
- storing the received ratings via the trade secret documentation tool using a database on a mass data storage device connected to the accounting digital computer; and storing the calculated trade secret defendability metric via the trade secret documentation tool using a database on a mass data storage device connected to the accounting digital computer. (Barney: cols. 25, 28 – data stored on computer accessible memory device; searchable computer network database also used)
- calculating, via the trade secret documentation tool using an arithmetic processor of the accounting digital computer, a trade secret defendability metric for the potential trade secret from the received ratings; (Barney:

cols. 11, 26 – one of the factors of the statistical based rating is defensibility; defensibility is rated on scale of 1-10)

Furthermore, the data identifying the six factors of a trade secret from Section 757 of the Restatement (First) of Torts is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying the six factors of a trade secret from Section 757 of the Restatement (First) of Torts adds little, if anything, to the

claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

12. **With respect to claims 125 and 129:** (new) The method of claim 124 further comprising:

- determining, via the trade secret documentation tool using a comparison processor of the accounting digital computer, that the calculated trade secret defendability metric for the potential trade secret exceeds a predetermined threshold value; and (Barney: col. 28, lines 5-50 – patents are rated against other patents)
- identifying, in response to the determination, the potential trade secret as a defendable trade secret. (Barney: cols. 11, 26 – one of the factors of the statistical based rating is defensibility; defensibility is rated on scale of 1-10)

13. **With respect to claims 126 and 130:** (new) The method of claim 124 further comprising

- sorting, via the trade secret documentation tool using a comparison processor of the accounting digital computer, a plurality of the potential



trade secrets in increasing or decreasing numerical order of the calculated metric. (Barney: Figs. 5-6; col. 12, lines 7-52; col. 28, lines 5-50 – patents are ranked or rated)

14. **With respect to claims 127 and 131:** (new) The method of claim 125 further comprising:

- transmitting to a trade secret directory server, via the trade secret documentation tool using a communications processor of the accounting digital computer, a request for a trade secret certificate corresponding to the determined defensible trade secret; and receiving from the trade secret directory server, via the trade secret documentation tool using a communications processor of the accounting digital computer, a generated certificate corresponding to the determined defensible trade secret. (Barney: Fig. 11; cols. 28-30 – rating report generated )

15. **With respect to claim 132:** (new) A trade secret documentation tool for identifying a potential trade secret comprising: an accounting digital computer; a user interface device in connection with the accounting digital computer for presenting trade secret factors and for receiving ratings of the potential trade secret, the six trade secret factors corresponding to the six factors of Section 757 of the Restatement (First) of Torts and including (1) the extent to which the information is known outside of his business; (2) the extent to which it is known by employees and others involved in his business; (3) the extent of measures taken by him to guard the secrecy of the information; (4) the value of the information to him and to his competitors; (5) the

amount of effort or money expended by him in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others; (Barney: col. 12 – computer model or computer algorithm used)

- a mass data storage device in connection with the accounting digital computer for storing ratings received via the user interface and for storing a defendability metric for the potential trade secret; wherein the mass data storage device comprises computer-readable files containing a database, the six factors of a trade secret from Section 757 of the Restatement (First) of Torts, and associated numerical values; and wherein the accounting digital computer comprises an arithmetic processor and associated executable instructions for calculating the trade secret defendability metric for the potential trade secret from received ratings. (Barney: cols. 25, 28 – data stored on computer accessible memory device; searchable computer network database also used; col. 7, line 15- col. 8, line 67; col. 30, lines 25-45; cols. 25 and 26 – system to be used with intellectual property assets; numeric and alphanumeric scores assigned in rating assets)

16. **With respect to claim 133:** (new) The trade secret documentation tool of claim 132, wherein the accounting digital computer further comprises a comparison processor and associated executable instructions for determining that the calculated trade secret defendability metric for the potential trade secret exceeds a predetermined threshold value and identifying the potential trade secret as a defendable trade secret, and for

sorting a plurality of the potential trade secrets in increasing or decreasing numerical order of the calculated metric. (Barney: cols. 25, 28 – data stored on computer accessible memory device; searchable computer network database also used; col. 7, line 15-col. 8, line 67; col. 30, lines 25-45; cols. 25 and 26 – system to be used with intellectual property assets; numeric and alphanumeric scores assigned in rating assets; Figs. 5-6; col. 12, lines 7-52; col. 28, lines 5-50 – patents are ranked or rated)

17. **With respect to claim 134:** (new) The trade secret documentation tool of claim 133, wherein the accounting digital computer further comprises a communication processor and associated executable instructions in connection with a trade secret directory server, the trade secret directory server for generating and storing a certificate relating to the trade secret and for presenting the certificate in response to a query relating to the trade secret. (Barney: Fig. 11 – Rating report)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Barney to the current application claims 124-134 because Barney notes that the teachings applied to patents is applicable to trade secrets. Also, the use of a report in Barney is similar to the expected certificate in the current application. Both present a document to be used to show final results of rating/ranking study.

### **CONCLUSION**

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
3/26/09